

Application No.: 10/023,354

Docket No.: 65890-0002

**REMARKS**

Applicant has reviewed the office action dated March 2, 2005, and thanks Examiner Hartman for his indication of allowable subject matter and review of the pending claims. Claims 27-30 were allowed. Claims 1-7 and 9-26 were rejected and claim 8 was objected to. Claims 1, 4, 6, and 8 have been cancelled. New claims 31 and 32 have been added. Applicant has amended claims 2, 5, 7, 9, 10, 16, 22, and 24-26. However, by way of this amendment, no new matter has been added. Accordingly, claims 2, 3, 5, 7, and 9-32 remain pending in this application. Applicant respectfully requests reconsideration of the present application in view of the above amendment and the following remarks.

**Drawings**

The Examiner objected to the drawings as being informal. Applicant hereby submits formal replacement sheets of drawings with this response.

**Allowable Subject Matter**

Claim 8 was objected to as being dependent upon a rejected base claim, but indicated as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant has re-written claim 8 in independent form as new claim 31, including all of the limitations of the base claim and the intervening claims as suggested by the Examiner. Accordingly, claim 31 is now in condition for allowance.

Applicant thanks the Examiner for the indication that claims 27-30 were allowed.

**Claim Rejections Under 35 U.S.C. §102**

Claims 1-7, 9-16, 20-21 and 23-25 were rejected under 35 U.S.C. 102(b) as being anticipated by Kukuljan, (U.S. Patent No. 5,353,490). Applicant respectfully traverses the rejection.

As explained above, claim 8, which contained allowable subject matter, was rewritten in independent form as new claim 31. Pending claims 2-3, 5, 7, 9-17, 20-21, and 23-25 all now depend either directly or indirectly from now allowable claim 31. Accordingly, the

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Examiner's rejection of these claims is moot and withdrawal of the rejection is respectfully requested.

**Claim Rejections Under 35 U.S.C. §103**

Claims 17-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kukuljan, (U.S. Patent No. 5,353,490), as applied to claim 16 above, in view of Lapham, (U.S. Patent No. 6,442,451). Applicant respectfully traverses the rejection.

As explained above, claim 8, which contained allowable subject matter, was rewritten in independent form as new claim 31. Pending claims 17-19 all depend indirectly from now allowable claim 31. Accordingly, the Examiner's rejection of these claims is moot and withdrawal of the rejection is respectfully requested.

Claim 22 was rejected under 35 U.S.C. 103(a) as being unpatentable over Kukuljan, as applied to claim 21 above, in view of Hahn et al., (International Publication No. WO 01/48416 A1). Applicant respectfully traverses the rejection.

As an initial matter, claim 22 has been amended to depend from new claim 32. New claim 32 includes the limitation that the base unit includes at least one safety device configured to prevent operation of the automation apparatus during a function performed by the automation module that could result in injury to a user or to the automation apparatus. Claim 22 requires that the safety device is a light curtain.

The Examiner has conceded that Kukuljan fails to teach a light curtain as claimed by Applicant and has relied upon Hahn et al. as teaching this limitation. However, the Examiner has shown no motivation in the prior art of record to combine the cited references. Notably, the Examiner cites no portion of either Kukuljan or Hahn et al. as containing any suggestion whatsoever for providing a light curtain safety device that is electronically controlled by a base unit, whereby when a user reaches through the light curtain into an automation module during an operation where injury could result to either the user or the automation module, the base unit terminates operation of the automation module. Accordingly, the Examiner has failed to sustain his *prima facie* burden.

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Indeed, all that the Examiner has done is identify claim limitations in the prior art. However, "[i]f identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453 at 1457 (Fed Cir. 1998). "Rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability'." *Id.* quoting *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). Accordingly, withdrawal of the rejection is requested.

Claim 26 was rejected under 35 U.S.C. 103(a) as being unpatentable over Kukuljan, as applied to claim 21 above, in view of Official Notice. Applicant has amended claim 26 to depend from allowable claim 31. Accordingly, withdrawal of the rejection is requested.

### CONCLUSION

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Any fees due with this response is identified in the accompanying transmittal. However, if any additional fees are due, please charge our Deposit Account No. 18-0013, under Order No. 65890-0002 from which the undersigned is authorized to draw.

Dated: June 2, 2005

Respectfully submitted,

By 

Kristin L. Murphy

Registration No.: 41,212

RADER, FISHMAN &amp; GRAUER PLLC

39533 Woodward Avenue

Suite 140

Bloomfield Hills, Michigan 48304

(248) 594-0647

Attorney for Applicant

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